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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,955	06/15/2000	Ralph F. Conley JR.	DBT-002	9875

7590 08/16/2004

Steven J Rosen
4729 Cornell Road
Cincinnati, OH 45241

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/594,955

Applicant(s)

CONLEY, RALPH F.

Examiner

Douglas B Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 56-61 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,666,500 to Roberson.
4. As to claim 56, Roberson teaches software stored in a machine readable format comprising: a means for displaying an icon on a screen on an end-user computer said icon operable to launch the software (col. 5, lines 14-24), a means for accessing and displaying data on said end-user computer (col. 5, lines 14-24), a means for detecting a network connection and executing a transaction with a network server to determine if at least some of said data should be updated (col. 4, lines 28-50), a means for executing said transaction and updating said data (col. 4, lines 28-50), and an alerting means for altering an appearance of said icon on said screen after said data is updated (col. 4, lines 51-67).
5. As to claim 57, Roberson teaches the software as claimed in claim 56 wherein said data is stored on said end-user computer (col. 5, lines 14-24).

6. As to claim 58, Roberson teaches the software as claimed in claim 57 wherein said data is e-mail (col. 5, lines 14-24).

7. As to claim 59, Roberson teaches the software as claimed in claim 56 wherein said altering an appearance of said icon includes changing a color of said icon (col. 4, lines 54-55).

8. As to claim 60, Roberson teaches the software as claimed in claim 56, wherein said altering an appearance of said icon includes highlighting said icon (col. 4, lines 54-55).

9. As to claim 61, Roberson teaches the software as claimed in claim 56 wherein said alerting means further comprises a means of returning appearance of said icon on said screen to an unaltered appearance after updated data has been displayed on said screen, said altered appearance being the same as before said appearance was altered (col. 5, lines 14-24).

10. Claims 1, 28, 32, 36-37, 40, 41, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,742,768 to Gennaro et al..

11. Gennaro teaches the invention as claimed (as in exemplary claim 49) including a banner display publishing system comprising: a publishing server connected to the network, publishing software operably running on said server said publishing software operable for producing and changing banner software that is used to display banners (col. 3, lines 27-64, any web server reads on a publishing server with publishing software as so broadly claimed by the applicant, including that taught by Gennaro.), said publishing software comprising: a means for selecting navigation options for the banner software, wherein the banner software is in machine readable format having a banner display means for displaying a banner on a screen on an end-user computer, said banner display means having a menu display means for presenting a menu of navigation options when an end-user clicks on said banner, and at least a portion of said

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navigation options are URLs on said network to which said end-user computer is connectable (col. 4, lines 31-53); and a means for storing said banner software on said server, and a means for distributing said banner software to said end-user computer (col. 3, lines 27-64).

12. As to claims 1, 28, 36, 40, and 41, they feature the same limitations as claim 49 and are rejected for the same reason as claim 49.

13. As to claim 32, Gennaro teaches the software of claim 28, further comprising an installation means for installing the banner software in an application (col. 3, lines 26-64).

14. As to claim 37, Gennaro teaches the software as claimed in claim 36 further comprising an alerting means for alerting the end-user that the message has been sent to the end-user computer (col. 3, lines 26-64, displaying a banner is considered alerting the user of a message).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-27, 29, 31, 33-34, 42-48, and 50-53 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,742,768 to Gennaro et al. in view of U.S. Patent Number 6,141,010 to Hoyle.

17. As to claims 2, 11, 17, 25, and 42, Gennaro does not explicitly teach the maintenance of a local database.

Hoyle teaches a means for monitoring end-user's behavior regarding accessing said banner, a means for maintaining a local event statistics database of said end-user's behavior regarding accessing said banner, and a means for transmitting information in said local event statistics database to a server computer on said network (col. 7, lines 6-13).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying navigation options with the teachings of Hoyle regarding the monitoring of a user's behavior because information about a user's interaction with a banner allows an advertiser to subsequently send more relevant banners (Hoyle, col. 16, lines 9-23).

18. As to claims 3, 12, 18, 26, and 43, Hoyle teaches a local event statistics database including the number of times a banner was accessed by an end-user (col. 11, line 50- col. 12, line 26).

19. As to claims 4, 13, 19, 27, and 44, Hoyle teaches a local event statistics database further including URLs on a network to which end-user computer has been directed through a choice from navigation options (col. 11, line 50- col. 12, line 26).

20. As to claims 5 and 20, Hoyle teaches the use of nested menus in a menu of navigation options (Figure 5A).

21. As to claim 6, Hoyle teaches the use of cascading menus in a menu of navigation options (Figure 5A).

22. As to claim 7, 14, 21, 29 and 45, Gennaro does not explicitly teach storing files locally.

Hoyle teaches options including one or more addresses to files stored on fixed storage means for fixedly storing files on the end-user computer (col. 10, lines 35-51).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying navigation options with the teachings of Hoyle regarding storing files locally because a user may want to utilize a client application stored locally (Hoyle col. 10, lines 35-51).

23. As to claims 8, 15, 22, and 46, Hoyle teaches the use of a hard drive and CD-ROM drive (col. 7, lines 14-26).

24. As to claims 9, 23, 47, and 50, Gennaro does not explicitly teach updating banners.

Hoyle teaches a means for detecting a network connection and executing a transaction with a network server to determine if at least one of said banner and said navigation options should be updated (col. 11, line 50-col. 12, line 26).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying navigation options with the teachings of Hoyle regarding updating banners because updating banners allows for better advertising (Hoyle, col. 8, lines 30-52).

25. As to claims 10, 48, and 51, Hoyle teaches a means for updating a banner and a navigation option (col. 11, line 50-col. 12, line 26).

26. As to claim 16, Gennaro does not explicitly teach updating banners.

Hoyle teaches a banner updating means for allowing a publisher to change said navigation options (col. 11, line 50-col. 12, line 26).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying

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navigation options with the teachings of Hoyle regarding updating banners because updating banners allows for better advertising (Hoyle, col. 8, lines 30-52).

27. As to claim 31, Gennaro does not explicitly teach means for selecting an image.

Hoyle teaches a means for selecting a banner image file for the banner display means to display as the banner (col. 14, line 46-col. 15, line 28).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying navigation options with the teachings of Hoyle regarding the selection of banner images because an advertiser may want to change banners (Hoyle, col. 14, line 46-col. 15, line 28).

28. As to claim 33, Genarro does not explicitly teach a means for updating banner software.

Hoyle teaches a means for updating banner software in an application (col. 13, line 44-col. 14, line 5).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gennaro regarding a means for displaying navigation options with the teachings of Hoyle regarding the updating of software because new functionality could be added with new software (Hoyle, col. 13, line 44-col. 14, line 5).

29. As to claim 52, Gennaro teaches messaging software operable on a server computer for producing and sending a message that appears on the screen of end-user computers having banner software installed and a means for displaying said message when said banner is displayed on a screen on an end-user computer (col. 4, lines 31-53).

30. As to claim 34 and 53, Hoyle teaches an alerting means for alerting the end-user that the banner software has been changed on the end-user computer (col. 16, lines 24-52).

31. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,742,768 to Gennaro et al. in view of U.S. Patent Number 6,141,010 to Hoyle in further view of U.S. Patent Number 6,678,663 to Mayo.

32. As to claim 30, the Gennaro-Hoyle combination does not explicitly teach linking an email address as an option.

Mayo teaches the option of linking an email address of an advertiser (col. 7, line 43-col. 8, line 12)

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Gennaro-Hoyle combination regarding displaying navigation options with the teachings of Mayo regarding the linking of email addresses because email provides a way to contact an advertiser (Mayo, col. 7, line 43-col. 8, line 12).

33. Claims 35, 38-39 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,742,768 to Gennaro et al. in view of U.S. Patent Number 6,141,010 to Hoyle in further view of U.S. Patent Number 5,666,500 to Roberson.

34. As to claims 35, 38, and 54, Hoyle teaches alerting a user that a banner has changed and the use of icons; however the Gennaro-Hoyle combination does not explicitly teach an icon changing appearance to alert an end-user.

Roberson teaches an alerting means altering the appearance of an icon on a screen of the end-user computer (col. 4, lines 54-55).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Gennaro-Hoyle combination regarding

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displaying navigation options with the teachings of Roberson regarding the altering the appearance of an icon because altering the appearance of an icon attracts a user's attention (Roberson, col. 4, lines 54-55).

35. As to claims 39 and 55, the icon taught by Roberson can be considered a button because when clicked on it launches software.

Response to Arguments

36. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

Handwritten signature of Douglas Blair, consisting of the letters 'DBB' in a stylized, cursive font.Handwritten signature of Jack B. Harvey in cursive script.

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER